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REMARKS

The Applicants note with appreciation the Examiner's thorough review of the application.

In The Claims

Claim 1 has been amended to remove the phrase "a plurality of senders of said mail pieces, each of said senders to fill a container with said mail pieces." The phrase "one or more holding facilities to receive said containers from said senders and gather said containers into one or more pools" has been amended to read – **one or more holding facilities to receive a plurality of containers containing one or more mail pieces from a plurality of senders, wherein a program rate of postage is applied to each of said one or more mail pieces, said program rate being less than a full rate set by a postal service for mailing an unsorted mail piece, and to gather said containers into one or more pools –**

In claim 4, the phrase "a said program postage rate" has been corrected to read – **said program postage rate –**.

Claim 37 has been amended to remove the phrase "a plurality of senders of said mail pieces, each of said senders to fill a container with said mail pieces." The phrase "a transport business to receive said containers from said senders and gather said containers into one or more pools at one or more holding facilities" has been amended to read – **a transport business to receive a plurality of containers containing one or more mail pieces from a plurality of senders and to gather said containers into one or more pools at one or more holding facilities –**.

The preamble of claim 39 has been amended. The phrase "wherein said agreement further provides that each of said senders may" has been amended to read – **wherein, in accordance with said agreement, said plurality of senders: –**.

Similarly, the preamble of claim 40 has been amended. The phrase "wherein said agreement further provides that said transport business may" has been amended to read – **wherein, in accordance with said agreement, said transport business: –**. To maintain

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subject-verb agreement, the singular method steps have been amended to be plural. The phrase “from said senders who desire entry” has been amended to read – **from other senders who desire entry** –.

The preamble of claim 41 has also been amended. The phrase “wherein said agreement further provides that said pre-sorting business may” has been amended to read – **wherein, in accordance with said agreement, said pre-sorting business:** –. To maintain subject-verb agreement, the singular method steps have been amended to be plural.

Please cancel claims 3, 14, and 38 without prejudice.

Claim Rejections – 35 U.S.C. § 101

The Examiner rejected claims 1-18 under Section 101, to the extent the claims recited non-statutory subject matter; specifically, human mail senders. The Applicants disagree with the position that human beings may not participate in patented systems. Nevertheless, claim 1 has been amended, for other reasons, to more clearly recite the embodiment being claimed.

Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 39-41 under Section 112 as being indefinite. Claims 39-41 have been amended to remove the term “may” and to more clearly recite the embodiment being claimed.

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Claim Rejections – 35 U.S.C. § 103

The Examiner rejected independent claims 1, 37, and 57 under Section 103(a) as being obvious and unpatentable over U.S. Patent 5,377,120 to *Humes et al.*, in view of European application EP 0 575 109 A1 filed by *Oh*.

MPEP § 2142: A *prima facie* case of obviousness requires that: (1) the prior art references teach or suggest all of the features of the claimed invention; (2) there is some suggestion or motivation to modify or combine the prior art references; and, (3) there is a reasonable expectation of success in combining the prior art references. MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.” MPEP § 2142; *In re Geiger*, 815 F.2d 686, 690 (Fed. Cir. 1987).

Independent Claim 1: The Examiner acknowledges that “*Humes* does not specifically teach that said stacks of mail pieces are received in containers at one or more holding facilities for gathering said containers into one or more pools.” (Office Action at p. 4). The Examiner, however, compares the containers of unsorted mail pieces in claim 1 to the cages 45 of trays containing sorted mail pieces disclosed in the *Oh* application. The use of cages 45 to hold trays of sorted mail in *Oh* does not teach or suggest the pooling of containers as recited in claim 1, as amended. Moreover, combining the use of cages 45 to hold trays of sorted mail with the system disclosed in *Humes* would not teach or suggest all the features of the embodiment recited in claim 1.

All claim limitations must be considered, especially when one or more limitation is missing from the cited art. *Humes* does not teach the gathering of containers into one or more pools, as admitted by the Examiner. The *Oh* application does not teach or suggest all the features recited in claim 1. Because all the features are not taught or suggested by either reference, or by the combination, the rejection of claim 1 is not supported by the art and should be withdrawn.

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Independent Claim 37: The Examiner acknowledges that "*Humes* does not specifically teach that said stacks of mail pieces are received in containers which are delivered via a transport business." (Office Action at p. 5). The Examiner again compares the containers of unsorted mail pieces in claim 37 to the cages 45 of trays containing sorted mail pieces disclosed in the *Oh* application. The use of cages 45 to hold trays of sorted mail in *Oh* does not teach or suggest the pooling of containers before pre-sorting, as recited in claim 37. All claim limitations must be considered, especially when one or more limitation is missing from the cited art. Combining the use of cages 45 to hold trays of sorted mail with the system disclosed in *Humes* would not teach or suggest all the features of the embodiment recited in claim 37. Because all the features are not taught or suggested by either reference, or by the combination, the rejection of claim 37 is not supported and should be withdrawn.

Independent Claim 57: The Examiner acknowledges that "*Humes* does not specifically teach that said stacks of mail pieces are received in containers." (Office Action at p. 6). The comparison of the containers in claim 57 to the cages 45 in the *Oh* application does not teach or suggest all the steps of the method recited in claim 57. Because all the features are not taught or suggested by either reference, or by the combination, the rejection of claim 57 is not supported and should be withdrawn.

Dependent Claims: The Examiner rejects dependent claims 2-13, 15-18, and 39-41, stating "the additional limitations in Claims 2-13, 15-18 and 39-41 indicated the intended use of the system, not a structural element." (Office Action at p. 7).

Independent claim 1 recites a system, not an apparatus. Dependent claims 2-13 and 15-18 recite a variety of limitations on various elements of the system.

Independent claim 37 recites a cooperative enterprise, not an apparatus. Dependent claims 39-41 recite a variety of limitations on various elements of the cooperative.

The Examiner also states that "the structural limitations of [dependent] Claims 2-13, 15-18 and 39-41 are disclosed in *Humes* and *Oh* as described herein." (Office Action at p. 7). As discussed above, the independent claims (1, 37, and 57) recite features that are not taught or suggested by either *Humes* or *Oh*, separately or in combination. Likewise, the features recited in

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the dependent claims 2-13, 15-18, and 39-41 are not taught or suggested by either *Humes* or *Oh*, separately or in combination. Without a teaching or suggestion of all the features recited, the rejection of dependent claims 2-13, 15-18, and 39-41 is not supported by the prior art and should be withdrawn.

Rejected claims 14 and 38 have been canceled.

Claims 58-60: The Examiner discussed but did not reject dependent claims 58, 59, and 60. In any event, as discussed above, independent claim 57 recites features that are not taught or suggested by the cited prior art. Because the features recited in the dependent claims 58-60 are not taught or suggested by the prior art references, either alone or in combination, any rejection of dependent claims 58-60 would not be supported by the prior art.

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CONCLUSION

After the provisional election of claims and entry of the requested amendment, claims 1, 2, 4-13, 15-18, 37, 39-41, and 57-60 are pending in the application. The Applicants respectfully submit that all the pending claims of the application are patentable.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination of this application.

The Applicants do not believe any request for extension of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow the consideration of this paper, such extension is hereby petitioned for under 37 C.F.R. § 1.136(a) and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



J. Scott Anderson
Registration No. 48,563

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Atlanta Office (404) 881-7000
Fax (404) 881-7777

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to (571) 273-8300 at the U.S. Patent and Trademark Office on this, Monday, the twentieth (20th) day of March, 2006.


J. Scott Anderson

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